

## Remarks

In the Office Action dated March 3, 2004, the Examiner maintained the restriction of claims 1-68; rejected claims 1-14, 21, 23-25, and 31-35 under 35 U.S.C. § 101; rejected claims 10-12 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4 and 10 under 35 U.S.C. § 102(e) as being anticipated by *Randell et al.* (U.S. Patent Application Publication 2002/0194127) and *Remington et al.* (U.S. Patent No. 6,070,150), which is incorporated by reference by *Randell et al.*; rejected claims 7-9, 21-25, and 31-35 under 35 U.S.C. § 102(e) as being anticipated by *Gonen-Friedman et al.* (U.S. Patent Application Publication 200[1]/0047332); rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Randell et al.* (“the ’830 publication”) (U.S. Patent Application Publication 2002/0198830) in view of *Gonen-Friedman*; rejected claims 11-13 under 35 U.S.C. § 103(a) as being unpatentable over *Randell et al.* in view of *the ’830 publication*; and rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Gonen-Friedman et al.*

By this amendment, Applicants have canceled claims 2, 24, 25, 33, and 35 without prejudice or disclaimer, amended claims 1, 3-14, 21-23, and 31, 32, and 34, and withdrew claims 15-20, 26-30, and 36-68. Based on these amendments and the following remarks, Applicants respectfully traverse the rejection of claims 1-14, 21-25, and 31-35.

### **I. The Restriction of Claims 1-68**

The Examiner maintains the restriction requirement dated October 8, 2004. In making the requirement final, the Examiner asserts that “[t]he examples as provided are reasonable. The system as claimed has means to perform a variety of functions, which

reasonably can be combined different ways than the particular method claims recited. . . . [T]he computer as claimed an elements which can accomplish substantively different methods than those claimed.” (*Office Action*, page 2, lines 6-17.) The Examiner, however, does indicate that claims 55-68 “have been examined to the extent necessary to determine if the linking claims are rejected. As a result, it is noted that claims 55-68 are noted as rejected under the rejections of claims 1-14, respectively.” (*Office Action*, page 3, lines 1-3.)

Applicants assert the Examiner has not adequately addressed the arguments presented in the Response to Restriction Requirement dated November 4, 2004, and maintain the traversal of the Requirement with respect to Groups I and II, as presented by the Examiner. In an attempt to expedite prosecution of this application, however, Applicants respond to the rejections of claims 1-14, 21-25, and 31-35 below. In doing so, however, Applicants do not waive any of the arguments pertaining to the restriction of claims 1-68 as presented in the Response filed November 4, 2004, nor the right to petition the Restriction Requirement pursuant to 37 C.F.R. § 1.144.

## **II. Rejection of Claims 1-14, 21, 23-25, and 31-35 under 35 U.S.C. § 101**

The Examiner asserts that claims 1-14, 21, 23-25, and 31-35 are directed to non-statutory subject matter because the “method claims lack a technological element.” Although Applicants disagree with the Examiner’s cursory position, Applicants have amended these claims to recite “computer-implemented” methods that are performed in a system including a purchasing entity and a providing entity (e.g., claims 1-6) and a first and second processing entity (i.e., claims 7-9). As noted in Applicants’

specification, these entities have technological elements, as does a method that is “computer-implemented” and performed in a system including these entities. See *e.g.*, Applicants’ Specification, ¶ [046]. As such, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-14, 21, 23-25, and 31-35 under 35 U.S.C. § 101.

**III. Rejection of Claims 10-12 under 35 U.S.C. § 112, Second Paragraph**

Applicants have amended independent claim 10 to include, among other things, “performing a dispute resolution process between the purchasing and providing entities in response to the indication, wherein the dispute resolution process is performed for line items in the first invoice that have not been approved by the first approver.” Accordingly, it is clear that the dispute resolution process is performed on line items that have not been approved by the first approver. As such, Applicants request that the rejection of claim 10, and its dependent claims 11 and 12, under 35 U.S.C. § 112, second paragraph, be withdrawn.

**IV. Rejections of Claims 1-14, 21-25, and 31-35**

**a. The Examiner Has Not Explained the Pertinence of Each Reference as Required Under 37 C.F.R. § 1.104**

According to 37 C.F.R. § 1.104(c), the “pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” In rejecting claims 1-14, 21-25, and 31-35, the Examiner merely concludes that each reference teaches the recitations of particular claims without indicating where each reference

supports the Examiner's position or explaining the relevance of particular portions of these references. For example, in rejecting claim 1, the Examiner merely states,

'127 shows receiving a request from a first approver to access invoice data reviewed by another reviewer; providing the data to the approver; receiving a response to dispute (as shown in Remington); and performing dispute handling process with the purchasing entity and the providing entity (as shown in Remington).

(*Office Action*, page 4, lines 17-20.) Similar problems are noted for the other pending claims of Applicants' application. For instance, the Examiner makes numerous assertions that certain claims are rejected because "all elements are shown." See e.g., *Office Action*, page 6, line 15. Thus, the Examiner rejects Applicants' claims without pointing to any particular portion of the cited references. Instead, the Examiner attempts to improperly shift the burden to Applicants to identify any allegedly relevant passages from these references, and respond to them. Applicants submit that such practice does not meet the requirements of 37 C.F.R. § 1.104(c), which requires the Examiner to explain the pertinence of each reference relied upon in rejection Applicants' claims. As such, Applicants submit that the rejections of claims 1-14, 21-25, and 31-35 are improper because they do not afford Applicants an opportunity to make an informed decision regarding the Examiner's position associated with the cited references. Accordingly, Applicants request at least a new non-final Office Action explaining the Examiner's positions taken in the Office Action should the Examiner maintain any of the positions taken in the Office Action.

**b. The Rejection of Claims 1-4 and 10**

The Examiner asserts that *Randell et al.* and *Remington et al.* teach “receiving a request from a first approver to access invoice data reviewed by another reviewer; providing the data to the approver; receiving a response to dispute (as shown in Remington); and performing dispute handling process with the purchasing entity and the providing entity (as shown in Remington).” (*Office Action*, page 4, lines 19-22.) Applicants disagree. While *Randell et al.* and *Remington et al.* disclose systems for processing invoices between a merchant/biller 104 and first users 108 and 110, the systems do not receive a response reflecting a first approver's decision to dispute one or more line items included within one or more invoices, “wherein the first approver generates the first approver's decision based on an indication that the one or more line items have been reviewed by one or more other approvers associated with the purchasing entity,” as asserted by the Examiner.

*Randell et al.* arguably discloses features that enable a first user to approve an invoice and a second user to subsequently authorize its payment. The features require the biller to receive and validate decisions by the users. However, the authorizing user does not receive an indication that the first user has reviewed the invoice, nor does the authorizing user form a decision on the invoice based on such an indication.

*Remington et al.* does not teach or even suggest multiple users in a purchasing entity approving or disputing the same line items of an invoice.

Accordingly, neither of the cited references disclose the recitations of claim 1 and Applicants respectfully request that the Examiner withdraw the rejection of this claim under 35 U.S.C. § 102(e) and allow the claim.

Applicants cancelled claim 2 without prejudice or disclaimer. Accordingly, the rejection of this claim is moot.

Claims 3 and 4 depend from claim 1. As explained, claim 1 is distinguishable from *Remington et al.* and *Randell et al.* Accordingly, claims 3 and 4 are also distinguishable from these references for at least the same reasons set forth in connection with claim 1. Further, the cited references do not teach or even suggest the recitations of these claims, including

receiving an indication reflecting a selection of a first invoice included in the list of one or more invoices, wherein the first invoice has been reviewed by a second approver associated with the purchasing entity; and displaying, on a display device, one or more line items included in the first invoice that have been reviewed by the second approver, wherein each of the displayed one or more line items indicate whether the second approver has disputed or approved a respective displayed line item,

as asserted by the Examiner. Therefore, Applicants request that the rejection of claims 3 and 4 be withdrawn and the claims allowed.

Further, *Remington et al.* and *Randell et al.* do not teach at least,

sending a notification to a first approver associated with the purchasing entity that one or more invoices generated by the providing entity have been reviewed by a second approver associated with the purchasing entity;

receiving a request, from the first approver in response to the notification, to access information reflecting the one or more invoices;

generating an in-box reflecting a list of the reviewed one or more invoices;

making the in-box available to the first approver;

receiving an indication by the first approver reflecting a selection of a first invoice included in the list, wherein the

first invoice includes at least a first line item that has been reviewed by the second approver;

receiving an indication reflecting whether the first approver approved the second approver's review of the first line item; and

performing a dispute resolution process between the purchasing and providing entities in response to the indication,

as asserted by the Examiner. As explained, *Randell et al.* does not disclose either the first and second users receiving an indication that the other user has reviewed a line item. Instead, the biller 104 receives results of the users' approval and/or authorization. Accordingly, because neither *Randell et al.* and *Remington et al.* support the rejection of claim 10, Applicants request that the rejection of this claim be withdrawn and the claim allowed.

**c. The Rejection of Claims 7-9, 21-25, and 31-35**

*Gonen-Friedman et al.* describes an online dispute resolution system that allows a customer to dispute invoices provided from a vendor. Disputed items of an invoice are provided to the vendor, where persons having different authorities may be allowed to approve or reject the disputed items. While *Gonen-Friedman et al.* discloses dispute resolution through different persons, these persons are associated with a vendor and not the customer that receives the invoice from the vendor. As such, *Gonen-Friedman et al.* does not teach at least,

receiving an indication of a line item that has been disputed by a first person associated with the first processing entity, wherein the line item is associated with an invoice comprising a plurality of line items and the first person disputes the line item in response to receiving an indication reflecting that the line item has been reviewed by a second person associated with the first processing entity,

as asserted by the Examiner. Accordingly, Applicants request that the rejection of claim 7 be withdrawn and the claims allowed.

Although the Examiner indicates that claims 8 and 9 are rejected under 35 U.S.C. § 102(e), the Examiner did not address the recitations of these claims in the body of the rejection. (See *Office Action*, page 5, lines 5-10.) Further, claims 8 and 9 are distinguishable from the cited art for at least the same reasons set forth in connection with independent claim 7. Accordingly, the rejections of these claims are improper, and Applicants request that they be withdrawn and the claims allowed.

Additionally, *Gonen-Friedman et al.* does not teach, at least, assigning the invoice to a first person of the purchasing entity, receiving an indication reflecting whether the disputed line item is valid, updating a status of the disputed line item based on the indication and making the status available to a second person of the purchasing entity, as asserted by the Examiner. As discussed in *Gonen-Friedman et al.*, the persons that share review responsibilities are associated with a vendor and a Credit Memo Request (CMR) that is generated by the vendor in response to a dispute by a customer. These features do not disclose the above-noted recitations of claim 21, as asserted by the Examiner. Accordingly, Applicants request that the rejection of this claim be withdrawn and the claim allowed.

Applicants cancelled claims 24 and 25 without prejudice or disclaimer. As such, the rejection of these claims are moot. Further, claims 22 and 23 depend from claim 21. As explained, claim 21 is distinguishable from *Gonen-Friedman et al.* Accordingly, claims 3 and 4 are also distinguishable from this reference for at least the same reasons



set forth in connection with claim 21. Therefore, Applicants request that the rejection of claims 22 and 23 be withdrawn and the claims allowed.

Additionally, *Gonen-Friedman et al.* does not teach or suggest, “initiating a line item dispute handling process based on the received first decision data, the line item dispute handling process including: receiving second decision data reflecting a second decision by a second individual associated with the purchasing entity, the second decision being based on the first decision data; and presenting the first individual with data reflecting the second decision by the second individual,” as recited in claim 31. As explained, persons associated with a vendor review CMRs to determine whether a disputed item by a customer may be approved or rejected. Nowhere does the reference discuss present a person of a purchasing entity with data reflecting a decision by a second person of the purchasing entity regarding a disputed line item. Accordingly, Applicants request that the rejection of claim 31 be withdrawn and the claim allowed.

Applicants have cancelled claims 33 and 35. As such, the rejection of these claims are moot. Further, claims 32 and 34 depend from claim 31. As explained, claim 31 is distinguishable from *Gonen-Friedman et al.* Accordingly, claims 32 and 34 are also distinguishable from this reference for at least the same reasons set forth in connection with claim 31. Therefore, Applicants request that the rejection of claims 32 and 34 be withdrawn and the claims allowed.

**d. The Rejection of Claims 5 and 6**

The '830 publication discloses a invoice management system that allows operators 108, 110 of a customer 102 to dispute items of an invoice associated with a

merchant/biller 104. The '830 publication allows operators to review invoices and approve or dispute line items and provide associated reasons for any disputes. This information is provided to a merchant/biller for review. While the '830 publication discloses a line item dispute management process, the reference, and *Gonen-Friedman et al.*, fail to teach or suggest, at least, "making information reflecting the one or more disputed line items available to the providing entity, wherein the one or more disputed line items have been reviewed by different approvers associated with the purchasing entity in a hierarchical fashion," as asserted by the Examiner in connection with the rejection of claim 5. Nowhere do the references disclose or suggest a process where approvers of a common entity review line items in a hierarchical manner. Instead, a customer allows individuals to review and dispute line items without regard to other individuals. Because the cited art does not support the rejection of claim 5, Applicants request that the rejection of the claim be withdrawn and the claim allowed.

Claim 6 depends from claim 5. As explained, claim 5 is distinguishable from *Gonen-Friedman et al.* and the '830 publication. Accordingly, claim 6 is also distinguishable from these references for at least the same reasons set forth in connection with claim 5. Therefore, Applicants request that the rejection of claim 6 be withdrawn and the claim allowed.

**e. The Rejection of Claims 11-13**

Claims 11 and 12 depend from claim 10. As explained, claim 10 is distinguishable from *Randell et al.* Further, the '830 publication does not make up the deficiencies of *Randell et al.* Accordingly, claims 11 and 12 are also distinguishable

from these references for at least the same reasons set forth in connection with claim 10. Therefore, Applicants request that the rejection of claims 11 and 12 be withdrawn and the claims allowed.

Further, *Randell et al.* and the '830 publication do not teach or suggest, alone or in combination,

receiving a first notification reflecting that an invoice including a plurality of entries has been reviewed by a first person associated with the purchasing entity;

sending a request to review, by a second person associated with the purchasing entity, the reviewed invoice in response to the first notification;

generating an indication reflecting the disapproval by the second person of an entry included in the reviewed invoice; and

receiving a second notification reflecting whether the disapproval of the entry has been approved by the providing entity,

as asserted by the Examiner with respect to claim 13. As explained, neither of the two references disclose persons associated with the same purchasing entity that review entries of an invoice such that one of the persons receive an indication when another person has reviewed an invoice and reviewing the entries of the invoice. Accordingly, Applicants request that the rejection of claim 13 be withdrawn and the claim allowed.

**f. The Rejection of Claim 14**

As explained above in connection with claim 5, *Gonen-Friedman et al.* does not teach or even suggest, at least, “receiving an indication reflecting an entry that has been disputed by the purchasing entity, the entry having been reviewed by persons associated with the purchasing entity in a hierarchical fashion,” as recited in claim 14.

Instead, *Gonen-Friedman et al.* discloses a process that allows persons associated with a vendor to have various levels of review authority. Nowhere does the reference disclose a hierarchical review of invoices from the customer. Accordingly, Applicants request that the rejection of claim 14 be withdrawn and the claim allowed.

## **V. Conclusion**

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 3, 2005

By: \_\_\_\_\_

  
Joseph E. Palys  
Reg. No. 46,508